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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,087	03/19/2004	Juha R. Vallinen	042933/373950	7034

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EXAMINER	
FRIENEL, VANEL	

ART UNIT	PAPER NUMBER
3687	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/804,087	VALLINEN ET AL.	
	Examiner	Art Unit	
	VANEL FRENEL	3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-2, 5-10, 17-20, 27-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 12/04/09. Claims 1, 8 and 27 have been amended. Claims 1-2, 5-10, 17-20 and 27-28 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-2, 5-10, 17-20 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al (2002/0072412) in view of Brown et al. (2003/0115203) and further in view of Egendorf (6,188,994).

Regarding claim 1, Young shows a method comprising: initiating, "at a network server", a provision of a service for at least two parties (paragraph 4); verifying that each of the at least two parties is capable of paying for use of the service (paragraph 28); generating payment information "by providing for communication of" (paragraphs 28-30); and charging for use of the service based on the payment information (paragraph 30), "the principle comprising a definite choice of which of the at least two parties is responsible for paying the fee, wherein the definite choice is determined according to a result of a use of the service by one of the at least two parties that is different from a

result of a use of the service by the at least one other of the at least two parties (See Brown, Abstract, Page 2, Paragraph 0025).

Young discloses all the limitations above. Young does not explicitly disclose that the method having "by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information".

However, this feature is known in the art, as evidenced by Brown. In particular, Brown suggests that the method having "by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information" (See Brown, Page 3, Paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system Young with the motivation of providing a link, or reference to a subscriber's data page may be sent to another party when the subscriber requests a connection with that party or the other party requests a connection with the subscriber, while the subscriber and called party are connected, or after the connection (See Brown, Page 1, Paragraphs 0010-0011).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of "and wherein “providing for communication of” the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for

paying for use of the service" and "notifying the network server of the agreement"; charging for use of the service based on the payment information.

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having "and wherein "providing for communication of" the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" (See Egendorf, Fig.I; Fig.2; Col .3, lines 20-41; Col .4, lines 59-67 to Col.5, line 12); and "notifying the network server of the agreement"; charging for use of the service based on the payment information (See Egendorf Col.3, lines 20-41; Col .4, lines 59-67 to Col.5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col .2, lines 1-3).

Regarding claim 2, Young shows the limitation wherein the step of initiating comprises initiating a provision of a game (abstract).
Regarding claim 5, Young shows defining the occurrence to be losing a game (paragraphs 4, 22).

Regarding claim 6, Young shows reserving for a party payment resources from a prepaid account of the party and including information of the reserved payment

resources in the payment information (paragraph 25).

Regarding claim 7, Young shows reserving the payment resources in an online charging system (paragraph 26).

Regarding claim 8, Brown discloses the method further comprising charging the service to the reserved and returning unused payment"(See Brown, Page 3, Paragraph 0032).

Regarding claim 9, Brown discloses the method wherein the charging comprises charging the service to one of the at least two parties" (See Brown, Page 3, Paragraph 0032).

Regarding claim 10, Brown discloses the method further comprising sending at least one message in accordance with Session Initiation Protocol (See Brown, Page 2, Paragraph 0022).

Regarding claim 17, Young shows an apparatus, comprising: an enabler configured simultaneous provision of a service for at least two parties (paragraph 4); a verifier configured to verify that the at least two parties using the service are capable of paying for use of the service (paragraph 28); and a generator configured to provide payment information for the use of the service by the at least two parties for use in charging for the use of the service (paragraphs 28-30).

Young does not explicitly disclose that the apparatus having "by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information". However, this feature is known in the art, as evidenced by Brown. In particular, Brown suggests that the apparatus having "by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information"(See Brown, Page 3, Paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system Young with the motivation of providing a link, or reference to a subscriber's data page may be sent to another party when the subscriber requests a connection with that party or the other party requests a connection with the subscriber, while the subscriber and called party are connected, or after the connection (See Brown, Page 1, Paragraphs 0010-0011).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" and "notifying the network server of the agreement"; charging for use of the service based on the payment information.

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having "and wherein communicating the at least one

message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" (See Egendorf, Fig.1; Fig.2; Col .3, lines 20-41 ; Col .4, lines 59-67 to Col .5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col .2, lines 1-3).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service"and "notifying the network server of the agreement"; charging for use of the service based on the payment information.

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" (See Egendorf, Fig.1 ; Fig.2; Col .3, lines 20-41 ; Col .4, lines 59-67 to Col .5, line 12) and "notifying the network server of the agreement"; charging for use of the service based on the payment information (See Egendorf, Fig.l; Fig.2; Col .3, lines 20-41 ; Col .4, lines 59-67 to Col .5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col .2, lines 1-3).

Regarding claim 18, Young shows an apparatus further comprising: a charger configured to charge the service based on payment information (paragraph 26).

Regarding claims 19 and 20, Young shows an apparatus wherein the apparatus is one of a serving controller and an application server and the limitation wherein the apparatus is a game server (Fig. 1).

As per claim 27, Young discloses a computer program "product comprising at least one" computer readable "storage" medium "having computer-executable program instructions stored thereon" said computer-executable program instructions" configured to control a processor to perform: initiating a provision of a service for at least two parties (paragraph 4); verifying that of the at least two parties is capable of paying for use of the service (paragraph 28). Young does not explicitly disclose generating payment information by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information; and charging for use of the service based on the payment information.

However, this feature is known in the art, as evidenced by Brown. In particular, Brown suggests generating payment information by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information; and charging for use of the service based on the payment information "(See Brown, Page 3, Paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system Young with the motivation of providing a link, or reference to a subscriber's data page may be sent to another party when the subscriber requests a connection with that party or the other party requests a connection with the subscriber, while the subscriber and called party are connected, or after the connection (See Brown, Page 1, Paragraphs 0010-0011).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service".

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" (See Egendorf, Fig.I; Fig.2; Col .3, lines 20-41 ; Col .4,

lines 59-67 to Col .5, line 12), and "notifying the network server of the agreement"; charging for use of the service based on the payment information (See Egendorf, Fig.l; Fig.2; Col .3, lines 20-41 ; Col .4, lines 59-67 to Col .5, line 12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Col .2, lines 1-3).

As per claim 28, Young discloses an apparatus, comprising: enabling means for enabling simultaneous provision of a service for at least two parties (paragraph 4); verifying means for verifying that the at least two parties using the service are capable of paying for use of the service (paragraph 28).

Young does not explicitly disclose generating means generating payment information for the use of the service by at least two parties for use in charging for the use of the service by communicating at least one message between the at least two parties regarding a principle for paying a fee for the use of the service and including the principle in the payment information.

However, this feature is known in the art, as evidenced by Brown. In particular, Brown suggests generating means generating payment information for the use of the service by at least two parties for use in charging for the use of the service by communicating at least one message between the at least two parties regarding a

principle for paying a fee for the use of the service and including the principle in the payment information (See Brown, Page 3, Paragraph 0032).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system Young with the motivation of providing a link, or reference to a subscriber's data page may be sent to another party when the subscriber requests a connection with that party or the other party requests a connection with the subscriber, while the subscriber and called party are connected, or after the connection (See Brown, Page 1, Paragraphs 0010-0011).

Furthermore, Young and Brown teach all the limitations above, however, fail to teach this new limitation of "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" and "notifying the network server of the agreement"; charging for use of the service based on the payment information.

However, this feature is known in the art, as evidenced by Egendorf. In particular, Egendorf suggests that the method having "and wherein communicating the at least one message between the at least two parties comprises agreeing, between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for paying for use of the service" (See Egendorf, Fig.1 ; Fig.2; Col .3, lines 20-41 ; Col .4, lines 59-67 to Col .5, line 12) and "notifying the network server of the agreement"; charging for use of the service based on the payment information (See Egendorf, Fig.l; Fig.2; Col .3, lines 20-41; Col .4, lines 59-67 to Col .5, line 12). It would have been

obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Egendorf within the collective teachings of Brown and Young with the motivation of providing a secure method of billing commercial transactions over the Internet (See Egendorf, Co1.2, lines 1-3).

Response to Arguments

4. Applicant's arguments filed 12/04/09 with respect to claims 1-2, 5-10, 17-20 and 27-28 have been fully considered but they are not persuasive.

(A) At pages 6-9 of the response filed on 12/04/09, Applicant's argues the followings:

(i) Young, Brown and Egendorf do not teach "agreeing between the at least two parties, to an occurrence that unambiguously defines a party who is responsible for the use of the service.

(B) With respect to Applicant's argument, it is respectfully submitted that He relied upon the teaching of Egendorf (See Col.4, lines 49-67 to Col.5, line 20) which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 12/04/09 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view the teachings of Young, Brown and/or Egendorf based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as

detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091,231 USPQ 375 (Fed. Cir.1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/
Primary Examiner, Art Unit 3687
February 27, 2010